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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,836	06/22/2001	James S. Bradley	CFP-31802/02	7856

7590 02/04/2004

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EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Advisory Action	Application No.	Applicant(s)	
	09/887,836	BRADLEY, JAMES S.	
	Examiner	Art Unit	
	Walter B Aughenbaugh	1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to: *none*.

   Claim(s) rejected: *1-5,11 and 12*.

   Claim(s) withdrawn from consideration: *none*.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claim 11 and the cancellation of claim 12 in the After Final Amendment filed January 7, 2004 have not been entered due to the fact that the amendments to claim 11 raise new issues. The amendments to claim 11 render claim 11 indefinite under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Changing the claim language from reading a "film comprising...[an] adhesive resin... and a butylated phenolic antioxidant" to a "film formed by the process comprising the step of: applying [the] adhesive resin selected from the group consisting of: polyether urethanes, polyester urethanes, and polyurethane;..." introduces points of indefiniteness. A relationship between the adhesive resin and the antioxidant is not established in the claim as amended to include the "formed by the process" phrase, whereas prior to adding the "formed by the process" phrase, the film clearly comprised the adhesive resin and the butylated phenolic antioxidant. With the "formed by the process" phrase, the condition where the film comprises the adhesive resin and the butylated phenolic antioxidant is not the case. With the addition of the "formed by the process" phrase, it is no longer clear what the antioxidant is "present in" and to what the "concentration of between 1000 and 300,000 parts per million" refers (i.e. per million parts of what?). With the "formed by the process" phrase, it is not clear if the "from 0.00005 to 0.001 dry pounds per square foot" includes both the adhesive resin and the antioxidant, or solely the antioxidant as the construction of the claim, including the punctuation, indicates.

ANSWERS TO APPLICANT'S ARGUMENTS

2. Applicant's arguments on pages 4-6 of the After Final Amendment filed January 7, 2004 regarding the 35 U.S.C. 103 rejection of claims 1-5 over Saad et al. in view of Satoh et al. have been fully considered but are not persuasive.

Applicant's argument on page 4 that "Saad et al. teaches the formation of multi-layer films containing a volatile antioxidant only through film coextrusion" is irrelevant since the method of forming the laminate is not germane to the issue of patentability of the laminate itself. As first made of record in paragraph 14 of Paper 9, Saad et al. teach the structure as claimed by Applicant but fail to explicitly teach that the adhesive layer comprises a curing agent. Contrary to Applicant's argument that one of ordinary skill in the art would not have been motivated to combine Saad et al. and Satoh et al., one of ordinary skill in the art would have indeed been motivated to modify the adhesive layer of Saad et al. via the teaching of Satoh et al. for the reason provided in paragraph 14 of Paper 9, i.e. in order to effect superior adhesive bonding between the outer and inner ("control") layers of Saad et al. as taught by Satoh et al.

Applicant's assertion on page 4 that "a graft polymerization mixture according to Satoh et al. is simply incompatible with the coextrusion process detailed by Saad et al." is irrelevant because the method of forming the laminate is not germane to the issue of patentability of the laminate itself. In Examining article claims, the Office is concerned with the structure of the article taught by the prior art and not any particular process taught by the prior art that is used to make the article; multilayer films are made by other processes besides coextrusion. For instance, Satoh et al. disclose a coating process to form the laminate film of Satoh et al. (col. 26, line 66-col. 27, line 7); one of ordinary skill in the art would have recognized to have used a process

including the coating step of Satoh et al. to form the laminate structure taught by Saad et al. Applicant's alleged "reasons for failure" listed on page 5 are consequently irrelevant.

Applicant argues that the "notion of passive drying at room temperature or with moderate heating as detailed in Paper No. 11 as being an option is simply incompatible with multi-layer film formation according to Saad et al." is irrelevant; claims 1-5 are not process claims and therefore are not relevant to the "formation" of a multi-layer film. Furthermore, Paper 11 does not detail "passive drying at room temperature" as an option as Applicant states; on page 5 of Paper 11 it is stated: Satoh et al. actually teaches that "the temperature is set to 80°C-250°C" (col. 17, lines 49-51) and that "longer drying hours can bring about sufficient self-crosslinking property even at a relatively lower temperature" (col. 17, lines 52-54). 80°C, the lower limit of the temperature range taught by Satoh et al., is nowhere near room temperature.

In response to Applicant's citation of *In re Vaeck*, the "suggestion for the combined reference combination" (line 17 of page 5 of After Final Amdt., i.e. the motivation to combine) has been discussed above, and the reasonable expectation for success in making the combination of references as proposed in paragraph 14 of Paper 9 is based upon the teaching of Satoh et al., as stated in paragraph 14 of Paper 9, that "the inclusion of a curing agent (i.e. crosslinking agent) in the resin composition [improves] the adhesive property, water resistance and solvent resistance of the adhesive composition (col. 15, lines 58-62 and col. 17, lines 11-20)" where the resin composition is used to form an improved adhesion layer of a film that has superior adhesion between a substrate and the improved adhesion layer (col. 2, lines 9-12).

Contrary to Applicant's argument on page 6, one of ordinary skill in the art would have had a reasonable expectation of success in combining Saad et al. and Satoh et al. to form the

article as claimed by Applicant since Satoh et al. teach the inclusion of a curing agent (i.e. crosslinking agent) in the resin composition of an improved adhesion layer to improve the adhesive property, water resistance and solvent resistance of the adhesive composition (col. 15, lines 58-62 and col. 17, lines 11-20) of the improved adhesion layer of a film that has superior adhesion between a substrate and the improved adhesion layer (col. 2, lines 9-12). Applicant has not provided support for the statement made on page 6 that the position that one of ordinary skill in the art would have had a reasonable expectation of success in combining Saad et al. and Satoh et al. "represent[s] picking and choosing among the individual elements of the prior art references of record".

3. Applicant's arguments on page 6 of the After Final Amendment filed January 7, 2004 regarding the 35 U.S.C. 103 rejection of claim 11 over Omura et al. in view of Satoh et al. are rendered moot since the amendments to claim 11 in the After Final Amdt. have not been entered. In examining an article claim, recitation of "solventless application of resin" requires only that the resin is solventless in the final form of the article since the method of forming the film is not germane to the issue of patentability of the film itself.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
01/27/04 WBA

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/29/04